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10/064,350

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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY R. HAWES

Appeal 2009-003400
Application 10/064,350
Technology Center 3600

Decided: September 29, 2009

Before LINDA E. HORNER, JOHN C. KERINS,
and STEVEN D.A. McCARTHY, *Administrative Patent Judges.*

McCARTHY, *Administrative Patent Judge.*

DECISION ON APPEAL

1 STATEMENT OF THE CASE

2 The Appellant's claims being twice rejected, the Appellant appeals
3 under 35 U.S.C. § 134 (2002) from the Examiner's decision rejecting claims
4 31-39 under 35 U.S.C. § 102(e) (2002) as being anticipated by Takahashi
5 (US 6,273,631 B1, issued Aug. 14, 2001); rejecting claims 1-5, 13-19, 21

1 and 25 under 35 U.S.C. § 103(a) (2002) as being unpatentable over Mortvedt
2 (US 4,591,178, issued May 27, 1986) and Takahashi; rejecting claims 6, 7
3 and 9-11 under § 103(a) as being unpatentable over Mortvedt, Takahashi
4 and Burrell (US 3,765,636, issued Oct. 16, 1973); and rejecting claim 30
5 under § 103(a) as being unpatentable over Mortvedt, Takahashi and
6 Rowland (US 5,511,808, issued Apr. 30, 1996). The Examiner objects to
7 claims 12, 20, 22-24, 26-29 and 40-51 but indicates that the subject matter of
8 the claims is allowable. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

9 We sustain the rejection of claims 31-39. We do not sustain the
10 rejections of claims 1-30.

11 The claims on appeal relate to a fender assembly for a heavy duty
12 vehicle such as a semi-tractor. (Spec. 1, ¶¶ 0001-02). Independent claim 31
13 recites:

14 31. A fender mounting bracket for a
15 vehicle comprising a longitudinal frame that
16 carries ground engaging wheels above which is
17 supported a fender, the fender mounting assembly
18 comprising:

19 an elongated support arm adapted to be
20 mounted to either of an upper or lower surface of
21 the fender and defining a longitudinal axis;

22 a length-adjustable link connection having a
23 first portion connected to the elongated support
24 arm and a second portion adapted to be rotatably
25 mounted to a vehicle frame at a rotational axis
26 spaced from the longitudinal axis of the elongated
27 arm, wherein the offset spacing between the arm
28 longitudinal axis and the rotational axis can be
29 changed by adjusting the length of the link.

ISSUES

The Appellant argues independent claim 31 and its dependent claims 32-39 as a group for purposes of the rejection under § 102(e). (*See, e.g.*, App. Br. 5.) Claim 31 is representative of these claims. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008). With respect to these claims, the Appellant contends that Takahashi fails to disclose either a fender mounting bracket (App. Br. 5) or an elongated support arm adapted to be mounted to either of an upper or lower surface of a fender (App. Br. 6).

Apart from claim 31, claim 1 is the only other independent claim on appeal. Claim 1 recites a fender assembly combining a fender, a support arm and a bracket assembly including a length-adjustable link to selectively adjust the offset distance between a longitudinal axis of the elongated support arm and an axis of rotation of the bracket assembly. The Examiner concedes that Mortvedt does not disclose a bracket which allows an adjustment of length. (Ans. 4.) The Appellant contends that the Examiner has given no cogent reason why it would have been obvious to combine the teachings of Mortvedt and Takahashi so as to combine a bracket assembly including a length-adjustable link in a fender assembly with a fender and a support arm. (App. Br. 11.) The Appellant further contends that neither Burrell, in the case of claims 6, 7 and 9-11, nor Rowland, in the case of claim 30, makes up the perceived deficiencies in the teachings of Mortvedt and Takahashi. (App. Br. 11-12 and 13.)

This appeal turns on two issues:

Has the Appellant shown that the Examiner erred in finding that Takahashi discloses a structure capable of functioning as a fender mounting bracket which includes an

1 elongated support arm adapted to be mounted to either of an
2 upper or lower surface of a fender?

3 Has the Appellant shown that the Examiner failed to
4 articulate reasoning with some rational underpinning sufficient
5 to support the conclusion that the combined teachings of
6 Mortvedt and Takahashi, in the case of claims 1-5, 13-19, 21
7 and 25; of Mortvedt, Takahashi and Burrell, in the case of
8 claims 6, 7 and 9-11; or of Mortvedt, Takahashi and Rowland,
9 in the case of claim 30, would have provided one of ordinary
10 skill in the art reason to combine a bracket assembly including a
11 length-adjustable link in a fender assembly with a fender and a
12 support arm?

13
14 FINDINGS OF FACT

15 The record supports the following findings of fact (“FF”) by a
16 preponderance of the evidence.

17 1. Takahashi discloses a connecting rod with ball joints 2, 3 at
18 both ends of a rod-like connecting portion 1. (Takahashi, col. 3, ll. 37-39.)

19 2. Examples of environments for which Takahashi’s connecting
20 rod are designed include transmission control parts of automobiles and link
21 mechanism parts for height control sensors. (Takahashi, col. 1, ll. 14-19.)

22 3. The connecting portion 1 of Takahashi’s connecting rod
23 includes first and second connecting arms 5, 6 which respectively have
24 positioning teeth 4 arranged on surfaces thereof. The connecting portion 1
25 also includes a bolt 7 and a nut 8. The bolt 7 and the nut 8 cause the first
26 and second connecting arms 5, 6 to engage and the teeth 4 of the two

1 connecting arms 5, 6 to mesh. (Takahashi, col. 3, ll. 42-48 and figs. 1(a)-
2 1(c).)

3 4. The bolt 7 engages elongated holes in the connecting arms 5, 6
4 to adjust the length of the connecting portion 1. Adjusting the length of the
5 connecting portion 1 adjusts the distance between the centers of the first and
6 second ball joints 2, 3. (Takahashi, col. 3, ll. 39-41 and col. 4, ll. 35-40.)

7 5. Takahashi describes the first ball joint 2 as including a ball
8 receiving portion 21 formed integrally with an end of the arm 5. A ball-
9 shank 22 includes a ball portion 24 rotatably and tiltably wrapped or
10 received in the ball receiving portion 21. The ball-shank 22 also includes a
11 shank portion 23 with a threaded shaft end 25 extending from the ball
12 portion 24 which protrudes through an opening 27 in the ball receiving
13 portion 21. (Takahashi, col. 3, ll. 48-60 and col. 4, ll. 1-4.) The second ball
14 joint 3 has a similar structure, except that the shaft ends of the respective ball
15 shanks 22, 32 extend in opposite directions. (Takahashi, col. 4, ll. 41-53.)

16 6. Figure 3 of Takahashi depicts the shank portions 22 as being
17 elongated in the sense that the shank portions 22 are longer than they are
18 wide.

19 7. Takahashi does not disclose any means for limiting the rotation
20 of the ball-shanks 22 relative to the connecting arms 5, 6.

21 8. Mortvedt discloses a farm tractor 10 with a quick attach fender
22 20. (Mortvedt, col. 2, ll. 31-34 and 36-37.)

23 9. Mortvedt's fender 20 includes two stationary brackets 22, 24
24 and a shield assembly 26. Each of the two stationary brackets 22, 24
25 includes an elongated horizontal shaft 28, 36 and a bracket plate 30, 38
26 welded to one end of the horizontal shaft 28, 36. (Mortvedt, col. 2, ll. 37-41

1 and 45-47.) The shield assembly 26 includes sleeves 48, 50 which fit over
2 the horizontal shafts 28, 36 to mount the shield assembly 26 to the brackets
3 22, 24. (Mortvedt, col. 2, ll. 51-53 and col. 3, ll. 11-13.)

4 10. Mortvedt describes the tractor frame 12 as having a plurality of
5 holes 18. (Mortvedt, col. 2, ll. 34-35.) Figures 1 and 2 of Mortvedt depict
6 these holes as being arranged in a horizontal line on a side of the frame 12
7 over each wheel 15. Each of the bracket plates 30, 38 includes a hole 32, 40
8 for alignment with one of the holes 18 in the tractor frame 12 to fasten the
9 two brackets 22, 24 to the tractor frame 12 by means of bolts 24, 42.

10 (Mortvedt, col. 2, ll. 41-44 and 47-50.)

11 11. Mortvedt teaches that the brackets 22, 24 may be pivoted about
12 the bolts 34, 42 so that the horizontal shafts 28, 36 are in proper positions for
13 receiving the sleeves 48, 50 of the shield assembly 26. Once the positions of
14 the brackets 22, 24 have been properly ascertained, the brackets 22, 24 may
15 be secured permanently against movement by tightening the bolts 34, 42.

16 (Mortvedt, col. 3, ll. 21-27.)

17 12. Burrell discloses a vise clamp for holding pressure containers
18 for compressed and liquefied gases. (Burrell, col. 1, ll. 6-14.) Burrell's vise
19 clamp includes a nut 49 held loosely captive in a cage 50 recessed between
20 gussets 45. (Burrell, col. 3, ll. 16-19.)

21 13. Rowland discloses a flexible fender mount 12 including first
22 and second arms 14, 16 having ends affixed to the inside surface of a fender
23 10. The ends of the first and second arms 14, 16 opposite the fender 10 are
24 welded together and mounted on a flexible bushing 20. (Rowland, col. 2, ll.
25 44-55.)

PRINCIPLES OF LAW

A claim under examination is given its broadest reasonable interpretation consistent with the underlying specification. *In re American Acad. of Science Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). In the absence of an express definition of a claim term in the specification, the claim term is given its broadest reasonable meaning in its ordinary usage as the term would be understood by one of ordinary skill in the art. *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007); *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). Properties of preferred embodiments described in the specification which are not recited in a claim do not limit the reasonable scope of the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Nevertheless, “[i]t is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable.” *Id.* Consequently, “preambles describing the use of an invention generally do not limit the claims because the patentability of apparatus or composition claims depends on the claimed structure, not on the use or purpose of that structure.” *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002). A device disclosed in a prior art reference which includes each structural limitation recited in a claim and is susceptible of the use or purpose recited in the preamble anticipates the subject matter of the claim. *See Ex Parte Masham*, 2 U.S.P.Q.2d 1646, 1647 (BPAI 1987).

On the other hand, an examiner cannot establish a prima facie case that a claim is obvious “merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). In determining whether the subject matter of a claim would have been obvious, an examiner may

look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine known elements in the fashion claimed

Id. That said, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

ANALYSIS

Either of the two shank portions 23 of Takahashi's connecting rod (*see* FF 5 and 6) is an "elongated support arm adapted to be mounted to either of an upper or lower surface of" a fender as recited in claim 31. The Appellant in representative claim 31 does not limit either the structure of the fender which the claimed "fender mounting bracket" must mount or the structure of the longitudinal frame to which the fender must be mounted. As the Examiner points out (*see* Ans. 8), the shank portion at either end of Takahashi's connecting rod is "adapted to be mounted to either of an upper or lower surface of the fender" in the sense that the threaded shaft portion of

1 the shank portion is so structured that it can engage a threaded hole or sleeve
2 on either an upper or lower surface of a suitably configured fender. *See In*
3 *re Venezia*, 530 F.2d 956, 959 (CCPA 1970)(interpreting the term “each
4 sleeve of said pair adapted to be fitted over the insulating jacket of one of
5 said cables” as meaning that the sleeve was so structured or dimensioned
6 that it could fit over the insulating jacket). The threaded shaft portion of the
7 other shank portion is so structured that the threaded shaft portion can
8 engage a threaded hole in a suitably configured longitudinal frame. Since
9 the shank portions are elongated in the sense that they are longer than they
10 are wide (FF 6), either shank portion is an “elongated support arm adapted to
11 be mounted to either of the upper or lower surface of the fender”

12 The Examiner has not disregarded the preamble recitation that the
13 subject matter of representative claim 31 is a “fender support bracket.”
14 Neither the fender which the fender mounting bracket must mount; the
15 longitudinal frame to which the fender must be mounted; or the ground
16 engaging wheels over which the fender must be supported, is an element of
17 the claimed fender mounting bracket. As indicated in the previous
18 paragraph, the limitations reciting “an elongated support arm adapted to be
19 mounted to either of an upper or lower surface of the fender . . .” and “a
20 length-adjustable link having . . . a second portion adapted to be rotatably
21 mounted to a vehicle frame . . .” have meaning without reference to a
22 specific structure for the fender, the longitudinal frame or the wheels. This
23 implies that the preamble term “fender mounting bracket” refers to an
24 intended use of the subject matter of claim 31.

25 The Appellant has not provided evidence or argument sufficient to
26 support the conclusion that the term “fender mounting bracket” as used in

1 claim 31 and its dependent claims is limited to a bracket which affixes a
2 fender above a wheel or wheels of a vehicle so as to prevent any movement
3 of the fender relative to the longitudinal frame. The Appellant does not
4 point to any formal definition of the term “fender mounting bracket” in the
5 Specification. Neither does the Appellant provide evidence or argument
6 sufficient to show that the term “fender mounting bracket” has a meaning
7 among those of ordinary skill in the art narrower than merely a bracket for
8 mounting a fender. Although the Specification discloses at least one
9 example of a fender mounting bracket which, once installed, restrains the
10 fender from further movement (*see, e.g.*, Spec. 7, ¶ 0033), an example does
11 not limit the scope of a claim term unless the Specification and claim
12 language as a whole expressly disclaim a broader definition. *In re Bigio*,
13 381 F.3d 1320, 1325 (Fed. Cir. 2004). No such disclaimer is indicated in the
14 Specification or claim language here.

15 Takahashi’s connecting rod is a fender mounting bracket in the sense
16 that a pair of connecting rods is capable of mounting a suitable fender on a
17 suitable vehicle longitudinal frame over the vehicle’s wheels by engaging
18 threaded holes or sleeves on the fender and the longitudinal frame.
19 Takahashi does not disclose any means for limiting the rotation of the ball-
20 shanks relative to the connecting arms of Takahashi’s connecting rods. (FF
21 7). As the Appellant points out (*see* Reply Br. 2), a fender supported by
22 Takahashi’s connecting rods over a ground engaging wheel might tend to
23 sway, and might even contact the wheels, if the vehicle were moved. Claim
24 31 is not limited to a bracket which affixes a fender above a wheel or wheels
25 of a vehicle so as to prevent any movement of the fender relative to the
26 longitudinal frame, however. Takahashi’s connecting rod is a bracket

1 capable of mounting a fender and, as such, meets the “fender mounting
2 bracket” limitation of representative claim 31 even though a pair of such
3 connecting rods could not prevent all movement of the fender relative to the
4 longitudinal frame.

5 That said, the Examiner’s conclusion that it would have been obvious
6 “to make the bracket portion (38) taught by Mortvedt et al. adjustable using
7 the structure set forth by Takahashi et al., for the purpose of allowing the
8 angle of the fender to be adjusted” (Ans. 5) is conclusory and lacks rational
9 underpinning. Although Takahashi’s connecting rod is susceptible of use as
10 a fender mounting bracket, it is not designed for such an environment. (*See*
11 FF 2.) In particular, a mere substitution of one of Takahashi’s mounting
12 rods for Mortvedt’s bracket 24 would not allow the angle of the fender to be
13 adjusted. Mortvedt discloses adjusting the position and angle of the fender
14 by pivoting the brackets 22, 24 about bolts 34, 42 and then tightening the
15 bolts 34, 42 to permanently secure the brackets 22, 24 against pivotal
16 movement. (*See* FF 11.) Takahashi’s connecting rods have no means for
17 permanently securing the rods against pivotal movement. (*See* FF 7). A pair
18 of Takahashi’s connecting rods could not be merely substituted for
19 Mortvedt’s brackets 22, 24 because the connecting rods would not permit
20 the angle of the fender to be adjusted in the manner disclosed by Mortvedt.

21 Although Takahashi’s connecting rod is susceptible of use as a fender
22 mounting bracket, it is not designed for such an environment. (*See* FF 2.)
23 The existence of a connecting rod, designed for use in a different
24 environment, which was capable of rotational movement about its ball-
25 shanks as well as extension or contraction in length does not imply that one
26 of ordinary skill in the art would have recognized the utility of combining all

1 of these degrees of freedom when mounting a fender. Without such a
2 recognition, which appears only in the Appellant's Specification, there was
3 no apparent reason to combine the elements of claim 1 in the fashion
4 claimed. Since the Examiner provides no other apparent reason for
5 combining the teachings of Takahashi and Mortvedt, the conclusion that the
6 subject matter of claims 1-5, 13-19, 21 and 25 would have been obvious is
7 not supported.

8 In rejecting claims 6, 7, 9-11 and 30, the Examiner does not rely on
9 either Burrell or Rowland in articulating any reason why it would have been
10 obvious to combine a bracket assembly including a length-adjustable link
11 with a fender and an elongated support arm as recited in independent claim
12 1. (*See* Ans. 5-6.) The teachings of Burrell and Mortvedt (*see* FF 12 and
13 13) do not make up the deficiencies in the teachings of Takahashi and
14 Mortvedt so as to support a conclusion that the subject matter of claims 6, 7
15 and 9-11 would have been obvious from Takahashi, Mortvedt and Burrell or
16 that the subject matter of claim 30 would have been obvious from
17 Takahashi, Mortvedt and Rowland.

18 19 CONCLUSIONS

20 The Appellant has not shown that the Examiner erred in finding that
21 Takahashi discloses a structure capable of functioning as a fender mounting
22 bracket which includes an elongated support arm adapted to be mounted to
23 either of an upper or lower surface of a fender. Therefore, the Appellant has
24 not shown that the Examiner erred in rejecting claims 31-39 under
25 § 102(e) as being anticipated by Takahashi.

The Appellant has shown that the Examiner failed to articulate reasoning with some rational underpinning sufficient to support the conclusion that the combined teachings of Mortvedt and Takahashi, in the case of claims 1-5, 13-19, 21 and 25; of Mortvedt, Takahashi and Burrell, in the case of claims 6, 7 and 9-11; or of Mortvedt, Takahashi and Rowland, in the case of claim 30, would have provided one of ordinary skill in the art reason to combine a bracket assembly including a length-adjustable link in a fender assembly with a fender and a support arm. Therefore, the Appellant has shown that the Examiner erred in rejecting claims 1-5, 13-19, 21 and 25 under § 103(a) as being unpatentable over Mortvedt and Takahashi; in rejecting claims 6, 7 and 9-11 under § 103(a) as being unpatentable over Takahashi, Mortvedt and Burrell; and in rejecting claim 30 under § 103(a) as being unpatentable over Takahashi, Mortvedt and Rowland.

DECISION

We AFFIRM the Examiner's decision rejecting claims 31-39.

We REVERSE the Examiner's decision rejecting claims 1-7, 9-11, 13-19, 21, 25 and 30.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

Appeal 2009-003400
Application 10/064,350

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